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Paper No. 5

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FAXED

LEVER BROTHERS CO.
Junior Party,
(U.S. Patent No. 6,051,545),

JAN 21 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

HENKEL KGAA
Senior Party,
(U.S. Patent Application No. 09/380,739).

Patent Interference No. 105,143 (MPT)

NOTICE REDECLARING INTERFERENCE

This interference was declared between Lever Brothers Co. ("Lever") Patent No. 6,051,545 and Henkel KGAA ("Henkel") U.S. Application No. 09/380,739. During a conference call on October 29, 2003, Lever stated that they intended to file a motion for no interference in fact as well as a motion that Henkel's claims were unpatentable under 35 U.S.C. §103(a). The APJ administering the interference granted Lever leave to file these two motions. (Order Setting Times, Paper No. 17, p. 2).

During October 29, 2003 conference, Lever discussed filing motions to amend their patent claims and to have their claims designated as not corresponding. (Paper No. 17, p. 2). Lever however, was unable to explain how they intended to amend their claims as they are involved in this interference based upon an issued U.S. patent. As Lever was unable to explain their basis for amending patented claims during an interference, the APJ did not authorize the filing of any Lever motions seeking to amend their claims and have them designated as not corresponding to the count. Further, the APJ informed the parties that:

Only the two Lever motions described above (Rule 633(a) prior art and Rule 633(c) no interference-in-fact) are authorized. Prior to filing any additional preliminary motion, a party shall arrange for a conference call with the APJ to discuss the necessity of the additional motion.

(Paper No. 17, p. 2, emphasis in original). The APJ did indicate that Lever “may wish to consider filing a reissue application.” (Paper No. 17).

On January 2, 2004 the Board entered into the record a Lever notice under 37 C.F.R. §1.660(b) informing the Board that Lever had filed a reissue application.¹ Attached to Lever’s notice was a copy of a preliminary amendment that Lever filed in the reissue application. Lever’s sole statement with respect to the claim correspondence of the reissue claims is as follows:

As can be seen in the preliminary amendment attached hereto, the reissue application does not contain claims that correspond to the Count of the present interference.

(Lever Notice, Paper No. 21, p. 2).

¹A serial number has not yet been assigned to Lever’s reissue application.

I. Lever Has the Burden of Explaining Why its Claims Do Not Correspond

Prior to the filing of the reissue application, Lever had the burden of proving by a preponderance of the evidence that Lever was entitled to a decision that there was no interference in fact between its corresponding claims and those of Henkel. 37 C.F.R. §1.637. By filing a reissue application that amends all the patent claims and which provides only a cursory statement that the amended claims do not correspond, Lever attempts to circumvent its burden of proof that its claims do not interfere in fact with those of Henkel.

Lever's filing of a reissue application has placed the APJ in a difficult position. Under Rule 662(b) if a patentee in an interference files a reissue application that does not include a claim that corresponds to the count, the APJ may enter judgment against the patentee. Yet, the entry of adverse judgment could be misconstrued as a finding that Lever's reissue claims do not correspond to the count. The APJ has made no such finding.

There is a rebuttable presumption that the interference was properly declared. The amendment attached to Lever's notice amends all of Lever's corresponding patent claims and the notice merely concludes with attorney argument that none of the amended or added claims corresponds to the count. Indeed, the amendment does not provide any explanation of the differences between the amended claims and the underlying patent claims. Attorney argument and mere conclusory statements are not sufficient to satisfy the burden of rebutting the presumption that the originally designated claims were properly designated. Furthermore, it is not the Board's burden to search through the entirety of the record for evidence that potentially supports the attorney arguments and/or conclusory statements that the amendment to the claims

somehow rebuts that presumption. *Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1353, 58 USPQ2d 1737, 1745-1746 (Fed Cir. 2001). On this record, Lever has failed to provide a sufficient basis for the APJ to determine whether or not the amended and added claims should or should not be designated as corresponding to the count. On balance, the APJ concludes that Lever has not: 1) demonstrated that the original designation of their patent claims as corresponding to the count was in error; 2) provided a sufficient explanation demonstrating that the differences between their patented claims and their amended claims or added claims is of such a nature that the reissue claims do not interfere in fact with Henkel.

The APJ, on behalf of the Director, is of the opinion that Lever's amended reissue claims interfere with Henkel. As such, the APJ redeclares the present interference to Levers reissue application and, lacking sufficient evidence otherwise, designates all of Lever's reissue claims as corresponding to the count.

The Board has not yet received a copy of the reissue application filed by Lever. At this time the APJ is uncertain as to whether or not Lever has formally surrendered their 6,051,545 patent ("545"). Accordingly, the '545 patent will remain in the interference. Should Lever demonstrate that they have surrendered the '545 patent, the interference will be redeclared to remove the '545 patent from the interference.

Lever was previously authorized to file a motion for no interference in fact. Such authorization remains in effect. In addition to the two preliminary motions previously authorized (Paper No. 17), the APJ authorizes Lever to file a motion seeking to have their reissue claims

designated as not corresponding to the count.

In filing motions to redefine the interference (37 C.F.R. §1.633(c)), the moving party bears the burden of proof that they are entitled to the relief sought. 37 C.F.R. §1.637. Should Lever file a preliminary motion seeking to have their reissue application claims designated as not corresponding to the count, Lever is not required to establish that Lever's reissue claims are separate patentable inventions from Lever's '545 patent claims or vice versa.²

II. Lever's Request for Additional Time is Denied

During a conference call on January 13, 2004, Lever was informed that the interference would be redeclared.³ Counsel for Lever noted that the final time for taking action during the preliminary motions phase, Time Period 8, was set for July 12, 2004. Lever's counsel was concerned that Time Period 8 was quickly approaching and that, as no preliminary motions had yet been filed, there was a distinct possibility that the parties would be under significant time constraints to complete the interference within the times set. Lever requested that additional time be provided.

²There is no evidence of record to establish that Lever's patent claims represent potential 35 U.S.C. §102(g)/103 art against their reissue claims. Thus, there is little reason to have Lever demonstrate that their reissue claims are separate patentable inventions from their '545 patent claims prior to removing them from the interference.

³During the call, James McDonald represented Lever and James Olsen represented Henkel.

Lever did not consult the APJ designated as administering this interference or any other APJ prior to filing their reissue.⁴ Further, Lever did not seek the APJ's guidance with respect to their burden of proving that their reissue claims did not interfere in fact with Henkel and/or correspond to the present count. To the extent there has been a delay in the proceedings, the delay is the direct result of Lever's own independent actions, which falls short of a showing of good cause. 37 C.F.R. §1.645(a). Lever's request for additional time is denied.

III. Redeclaration

The interference is redeclared solely to add Lever's reissue application. The parties accorded priority benefits remains the same as provided in the original Notice Declaring Interference. (Paper No. 1). Further, Lever's reissue application is accorded the same priority benefit as that of their '545 patent, i.e., benefit of GB 9711831, filed June 6, 1997. (Paper No. 1, p. 3).

The count and claim correspondence is set forth below:

⁴At the January 13th conference call, Lever indicated that they had attempted to seek guidance regarding the filing of a reissue application from various USPTO representatives including Interference Practice Specialists ("IPS") within the Technology Centers as well as Board Administrators. The decision to enter judgment in the interference and designate Lever's reissue claims as not corresponding does not reside with either an IPS or a Board Administrator.

I believe that in this instance Lever was acting in good faith in their attempt to contact various USPTO officials regarding their procedural concerns. Yet, there is an appearance of forum shopping, which is not a basis for requesting relief.

Count 1

A tablet according to claim 1 of U.S. Patent No. 6,051,545

or

A detergent compact according to claim 4 of U.S. Application No. 09/380,739.

The claims of the parties are:

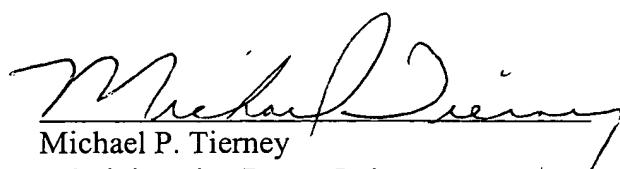
Lever (Boskamp), U.S. Patent No. 6,051,545:	1-15
Lever Reissue Application:	1-45
Henkel (Rettenmaier et al.), U.S. Application No. 09/380,739:	1-5, 8-10, 12-17 and 19-27

The claims of the parties which correspond to Count 1 are:

Lever Brothers (Boskamp), U.S. Patent No. 6,051,545:	1-15
Lever Reissue Application:	1-45
Henkel (Rettenmaier et al.), U.S. Application No. 09/380,739:	1-5, 8-10, 12-17 and 19-27

The claims of the parties which do not correspond to Count 1 are:

Lever Brothers (Boskamp), U.S. Patent No. 6,051,545:	None
Lever Reissue Application:	None
Henkel (Rettenmaier et al.), U.S. Application No. 09/380,739:	None


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